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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,233	10/26/2000	Joseph T. Pych	NMC-003.01	3470
25181	7590	11/07/2006	EXAMINER	
FOLEY HOAG, LLP			ROBINSON BOYCE, AKIBA K	
PATENT GROUP, WORLD TRADE CENTER WEST			ART UNIT	PAPER NUMBER
155 SEAPORT BLVD				
BOSTON, MA 02110			3628	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/697,233	PYCH, JOSEPH T.	
	Examiner Akiba K. Robinson-Boyce	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 September 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-8, 10-13, 17, 18, 56, 57 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-8, 10-13, 17-18, 56-57, 59-62 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### ***Status of Claims***

1. Due to communications filed 9/1/06, the following is a final office action. Due to a restriction requirement, claims 2-8, 10-13, 17-18, 56-57, 59-62 have been elected. Claims 1, 9, 14-16, 19-32, 44, 53-55, and 58 have been cancelled. Claims 2-8, 10-13, 17-18, 56-57, 59-62 are pending in this application and have been examined on the merits. Claims 2-8, 10-13, 17-18, 56-57, 59-62 are rejected as follows.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-8, 10-13, 17-18, 56-57, 59-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, in independent claims 59-60, the fourth limitation, claim 61, the fifth limitation, and claim 62, the seventh limitation, the term "one or more prospect lists" is a relative term that renders the claim indefinite. The term "one or more prospect lists" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Because the term "one or more prospect lists" is used, it is not clear which list is being discussed, thereby making the entire claim, and the scope of the invention unclear. Therefore, all claims that depend on independent claims 59-62, (claims 2-8, 10-13, 17-18, and 56-57) are also indefinite.

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Also, in independent claims 59-60, the fifth limitation, claim 61, the sixth limitation, and claim 62, the eighth limitation, the term "a second list group" is a relative term that renders the claim indefinite. The term "a second list group" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Because the term "a second list group" is used, it is not clear which list is being discussed since this "second list group" doesn't seem to be tied to any other list group, thereby making the entire claim, and the scope of the invention unclear. Therefore, all claims that depend on independent claims 59-62, (claims 2-8, 10-13, 17-18, and 56-57) are also indefinite.

As per claim 17, the term "the prospect list identifies at least one of the at least one other list purchaser" is a relative term that renders the claim indefinite. The term "the prospect list identifies at least one of the at least one other list purchaser" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Because the term "the prospect list identifies at least one of the at least one other list purchaser" is used, it is not clear which list is being discussed, thereby making the entire claim, and the scope of the invention unclear.

#### ***Response to Arguments***

Applicant's arguments filed 9/1/06 have been fully considered but they are not persuasive.

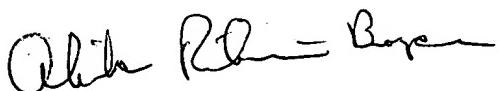
The applicant argues the restriction requirement filed 5/5/06. Specifically, the applicant argues that the inventions of both Groups I and II have the same effect: they both provide a first list purchaser with a targeted list of prospective customers, and the operation by which they obtain that effect is also the same: choosing prospective customers from a group of selected lists. Applicant then goes on to argue that the only difference is the criterion used for selecting the group of selected lists, where in Group I, the criterion for list selection is that the targeted list and a list identified as successful by the first list purchaser share similar content, whereas in Group II, it is that they share similar users. However, the inventions of Group I and Group II are distinct and require a different field of search since Group I focuses on targeting lists of prospective customers, where Group I focuses on targeting lists of prospective list purchasers. The difference is that the customers are only on one end of the transaction, and are not purchasers of the lists, but are resources used to create the target lists. As for the list purchasers, they are on both ends of the transaction; they purchase the list, and are also used as a resource to create target lists. This difference requires a different search.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.  
November 2, 2006